IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:	)	NCR Reference: **11447.10**
	)	
McGregor et al.	)	MMB Docket No. **1001-0821**
	)	
Application No. **09/832,767**	)	Examiner: **Donald Champagne**
	)	
Filed: **April 11, 2001**	)	Group Art Unit: **3622**
	)	
Title: **System for Generating Revenue Using Electronic Mail and Method for Its Use**	)))	

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Date of Signature

LETTER

Sir:

Enclosed is an Appeal Brief in connection with the above-identified patent application. The Notice of Appeal was filed on June 20, 2006, and the Appeal Brief is due two months from this date. Since the due date of filing the Appeal Brief fell on Sunday, August 20th, 2006, the Appeal Brief is being timely filed on Monday, August 21, 2006. Also enclosed herewith is a check for $500.00 to cover the fee required under 37 CFR 41.20(b)(2).

Additionally, please provide any extensions of time which may be necessary and charge any fees which may be due to Account No. 13-0014, but not to include any payment of issue fees.
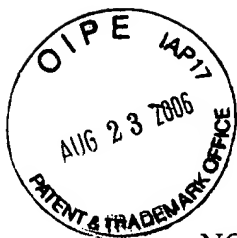
Respectfully submitted,

MAGINOT, MOORE & BECK LLP

August 21, 2006

Maginot, Moore & Beck LLP   James D. Wood
Chase Tower   Attorney for Appellants
111 Monument Circle, Suite 3250   Registration No. 43,285
Indianapolis, Indiana 46204-5109
(317) 638-2922 telephone
(317) 638-2139 facsimile

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

NCR Docket No. **11447.10**

MMB Docket No. **1001-0821**

Application of: **McGregor et al.**	Group Art Unit: **3622**
Serial No. **09/832,767**	Examiner: **Donald Champagne**

Filed: **April 11, 2001**

For: **SYSTEM FOR GENERATING REVENUE USING ELECTRONIC MAIL AND METHOD FOR ITS USE**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on <u>August 21, 2006</u>
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<u>James D. Wood</u>
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<u>August 21, 2006   </u>
Date of Signature

APPEAL BRIEF

Sir:

This is an appeal under 37 CFR § 41.31 to the Board of Patent Appeals and

Interferences of the United States Patent and Trademark Office from the rejection of the

claims 14, 15, 17-19, 21-25 and 27 of the above-identified patent application. These

claims were indicated as rejected in an Office Action dated March 20, 2006. The

$500.00 fee required under 37 CFR § 41.20(b) (2) is submitted herewith. Also, please

provide any extensions of time that may be necessary and charge any fees that may be

due to Account No. 13-0014, but not to include any payment of issue fees.

(1) REAL PARTY IN INTEREST

NCR Corporation of Dayton, Ohio is the assignee of this patent application, and

the real party in interest.

(2) RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to this patent application (serial no.

09/832,767).

(3) STATUS OF CLAIMS

Claims 14-25 and 27 are pending in the application.

Claims 16 and 20 are objected to.

Claims 14, 15, 17-19, 21-25 and 27 are rejected.

Claims 14, 15, 17-19, 21-25 and 27 are being appealed, and are shown in the

Appendix attached to this Appeal Brief.

(4) STATUS OF AMENDMENTS

Appellants have filed no amendments after receipt of the March 20, 2006, Office

Action (the "Office Action").

(5) SUMMARY OF CLAIMED SUBJECT MATTER

The present invention relates to a system and method whereby advertisement retrieval software is appended to an e-mail that has been sent by an e-mail user to another e-mail user. In accordance with one non-limiting embodiment, an e-mail user at a first client computer composes an e-mail. (See, e.g. Appellants' specification at page 24, lines 23-25 and block 73 of FIG. 7A). The e-mail is routed to a second client computer through a host server. (See, e.g. Appellants' specification at page 25, lines 3-6 and block 74 of FIG. 7A). The host server appends advertisement retrieval software to the e-mail (see, e.g. Appellants' specification at page 25, lines 12-17 and block 76 of FIG. 7A) and passes the e-mail to the second client computer. (See, e.g. Appellants' specification at page 28, lines 20-22 and block 78 of FIG. 7A). When the user at the second client computer accesses the e-mail, the advertisement retrieval software may be executed. (See, e.g. Appellants' specification at page 29, lines 1-3 and block 80 of FIG. 7A).

In a further embodiment, the user at the first client computer designates an entity, which may be a charitable organization. (See, e.g. Appellants' specification at page 10, lines 19-23). Accordingly, when the e-mail including the appended advertisement retrieval software is displayed at the second client computer, a contribution is made to the designated entity. (See, e.g. Appellants' specification at page 10, lines 19-23).

Thus, the present invention relates to the appending of advertisement retrieval software to an e-mail after the e-mail has been transmitted by the originator of the e-mail and prior to reception of the e-mail by the recipient.

The additional information required by the United States Patent Office is as follows.

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Claims 14, 21, 22 and 24

Claims 14, 21, 22 and 24 are argued together. Claims 14 and 21 are independent claims. Claim 14 recites:

14. A method for generating revenue using electronic mail, comprising the steps of:

transmitting an e-mail message addressed to at least one e-mail recipient from a first client computer to a host server through at least one computer network (see, e.g. Appellants' specification at page 24, lines 23-25 and block 73 of FIG. 7A and page 25, lines 3-6 and block 74 of FIG. 7A), wherein the e-mail message comprises an e-mail address of an e-mail user, an e-mail address of the at least one e-mail recipient, a subject, and a body (see, e.g. Appellants' specification at page 24, lines 24-26;

appending advertisement retrieval software means to the e-mail message transmitted from the first client computer (see, e.g. Appellants' specification at page 25, lines 12-17 and block 76 of FIG. 7A), wherein the advertisement retrieval software means comprises information about at least one of a plurality of advertisements retrievably stored in a database (see, e.g. Appellants' specification at page 28, lines 8-11 and block 117 of FIG. 11);

transmitting the e-mail message from the host server to a second client computer through the at least one computer network based upon the e-mail address of the at least one e-mail recipient (see, e.g. Appellants' specification at page 28, lines 20-23 and block 78 of FIG. 7A); and

displaying the e-mail message on the second client computer (see, e.g. Appellants' specification at page 29, lines 1-3 and block 80 of FIG. 7A), wherein when

the e-mail message is first displayed on the second client computer the advertisement

software retrieval means is operable at the second client computer to retrieve at least one

of the advertisements retrievably stored in the database for display with the e-mail

message on the second client computer (see, e.g. Appellants' specification at page 29,

lines 3-9 and block 80 of FIG. 7A).

Claims 15 and 25

Claims 15 and 25 are argued together. Claim 15 recites:

The method of claim 14, further comprising the step of:

storing profile information about the e-mail user in the database (see, e.g.

Appellants' specification at page 16, lines 15-21), and wherein the information about the

at least one of a plurality of advertisements stored in the database comprises target

characteristics associated with each of the plurality of advertisements (see, e.g.

Appellants' specification at page 20, lines 1-12), and wherein the step of appending

advertisement retrieval software means to the e-mail message comprises the steps of:

reading the e-mail user's e-mail address from the e-mail message (see, e.g.

Appellants' specification at page 25, lines 19-21 and block 101 of FIG. 10);

identifying the e-mail user according to the e-mail user's e-mail address (see, e.g.

Appellants' specification at page 25, lines 21-22 and block 102 of FIG. 10);

retrieving profile information about the e-mail user from the database (see, e.g.

Appellants' specification at page 25, lines 21-22 and block 102 of FIG. 10);

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comparing the e-mail user's retrieved profile information against the target characteristics associated with the advertisements (see, e.g. Appellants' specification at page 25, lines 23-25 and block 103 of FIG. 10);

selecting at least one advertisement comprising target characteristics which correlate positively to the e-mail user's profile information (see, e.g. Appellants' specification at page 25, line 25 through page 26, line 2 and block 104 of FIG. 10); and

appending advertisement retrieval software means to the e-mail message (see, e.g. Appellants' specification at page 26, lines 17-18 and block 105 of FIG. 10), the advertisement retrieval software means comprising information about the at least one selected advertisement (see, e.g. Appellants' specification at page 26, lines 18-20 and block 105 of FIG. 10).

Claim 17

Claim 17 is argued separately. Claim 17 depends from claim 14 and recites:

17.   The method of claim 14, further comprising the steps of:

transmitting a return communication from the second client computer to the host server when the e-mail message is displayed on the second client computer (see, e.g. Appellants' specification at page 29, lines 5-9); and

accounting for advertising revenue and advertising expense in response to the receipt of the return communication by the host server(see, e.g. Appellants' specification at page 34, lines 13-16).

Claims 18 and 27

Claims 18 and 27are argued together. Claim 18 is an independent claim and recites:

18.   A method for sending e-mail messages appended with advertising, comprising the steps of:

storing an identifier for an entity selected by an e-mail user (see, e.g. Appellants' specification at page 14, lines 22-26 and FIG .4);

transmitting an e-mail message addressed to at least one e-mail recipient from a first client computer to a host server through at least one computer network (see, e.g. Appellants' specification at page 30, lines 22-25 and block 704 of FIG .7B), wherein the e-mail message comprises an e-mail address of the e-mail user, an e-mail address of the at least one e-mail recipient, a subject, and a body (see, e.g. Appellants' specification at page 30, lines 17-21);

appending advertisement retrieval software means to the e-mail message transmitted from the first client computer (see, e.g. Appellants' specification at page 31, lines 13-15 and block 707 of FIG .7B), wherein the advertisement retrieval software means comprises information about at least one of a plurality of advertisements retrievably stored in a database (see, e.g. Appellants' specification at page 31, lines 13-15 and block 707 of FIG .7B);

transmitting the e-mail message from the host server to a second client computer through the at least one computer network based upon the e-mail address the of at least one e-mail recipient (see, e.g. Appellants' specification at page 31, lines 19-22 and blocks 708 and 709 of FIG .7B);

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displaying the e-mail message on the second client computer (see, e.g. Appellants' specification at page 32, lines 1-3 and block 711 of FIG .7B);

retrieving at least one of the plurality of advertisements retrievably stored in the database for display with the e-mail message on the second client computer (see, e.g. Appellants' specification at page 32, lines 6-9 and block 711 of FIG .7B); and

accounting for a contribution to the entity identified by the stored identifier (see, e.g. Appellants' specification at page 35, lines 3-8).

Claim 19

Claim 19 is argued separately. Claim 19 depends from claim 18 and recites:

19. The method of claim 18, further comprising the step of:

storing profile information about the e-mail user in the database (see, e.g. Appellants' specification at page 16, lines 15-21), and wherein the information about the at least one advertisement stored in the database comprises target characteristics associated with each advertisement(see, e.g. Appellants' specification at page 20, lines 1-12), and wherein the information about the e-mail user stored in the database comprises profile information about the e-mail user(see, e.g. Appellants' specification at page 16, lines 15-21), and wherein the step of appending advertisement retrieval software means to the e-mail message comprises the steps of:

reading the e-mail user's e-mail address from the e-mail message (see, e.g. Appellants' specification at page 25, lines 19-21 and block 101 of FIG. 10);

identifying the e-mail user according to the e-mail user's e-mail address (see, e.g. Appellants' specification at page 25, lines 21-22 and block 102 of FIG. 10);

retrieving profile information about the e-mail user from the database (see, e.g. Appellants' specification at page 25, lines 21-22 and block 102 of FIG. 10);

comparing the e-mail user's retrieved profile information against the target characteristics associated with the advertisements (see, e.g. Appellants' specification at page 25, lines 23-25 and block 103 of FIG. 10);

selecting at least one advertisement comprising target characteristics which correlate positively to the e-mail user's profile information (see, e.g. Appellants' specification at page 25, line 25 through page 26, line 2 and block 104 of FIG. 10); and wherein the step of appending comprises

appending information about the at least one selected advertisement to the e-mail message (see, e.g. Appellants' specification at page 26, lines 18-20 and block 105 of FIG. 10).

Claim 23

Claim 23 is argued separately. Claim 23 depends from claim 21 and recites:

23.   The method of claim 21, wherein the step of appending comprises:

obtaining the sub-message associated with an advertisement from a data base with a third computer (see, e.g. Appellants' specification at page 30, line 26 through page 31, line 8 and block 706 of FIG .7B); and

appending the sub-message associated with an advertisement to the e-mail enroute to the recipient with the third computer (see, e.g. Appellants' specification at page 31, lines 5-8 and block 706 of FIG .7B).

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 14, 15, 17-19, 21, 22, 24, 25 and 27 stand rejected under 35 U.S.C.

§102(e) as being anticipated by U.S. Patent Publication No. 20010025254 of Park

(hereinafter "Park").

Claim 23 stands rejected as obvious under 35 U.S.C. §103(a) over Park.

(7) ARGUMENT

Claims 14, 21, 22 and 24 Are Not Anticipated by Park

Discussion re: Patentability of Claim 14

1. <u>Claim 14</u>

Claim 14 recites the following:

14.   A method for generating revenue using electronic mail, comprising the steps of:
transmitting an e-mail message addressed to at least one email recipient from a first client computer to a host server through at least one computer network, wherein the e-mail message comprises an e-mail address of an e-mail user, an e-mail address of the at least one e-mail recipient, a subject, and a body;
appending advertisement retrieval software means to the e-mail message transmitted from the first client computer, wherein the advertisement retrieval software means comprises information about at least one of a plurality of advertisements retrievably stored in a database;
transmitting the e-mail message from the host server to a second client computer through the at least one computer network based upon the e-mail address of the at least one e-mail recipient; and
displaying the e-mail message on the second client computer, wherein when the e-mail message is first displayed on the second client computer the advertisement software retrieval means is operable at the second client computer to retrieve at least one of the advertisements retrievably stored in the database for display with the e-mail message on the second client computer.

Accordingly, claim 14 requires advertisement retrieval software to be appended to

an e-mail that has already been transmitted.

2.   Park Appends Prior to Transmission

The Examiner rejected claim 14 based upon the proposition that Park discloses appending an advertisement retrieval means to an e-mail. (Office Action at page 2). The Examiner has misconstrued the claim.

Specifically, the Examiner identified paragraph 41 of Park as disclosing the claimed step of appending. (Office Action at page 2). The actual teaching of Park is that an electronic stamp program 34 is installed on a user system. Thereafter, a user appends a stamp to an e-mail using the electronic stamp program 34. (Park at paragraph 46, step S12 of FIG. 3). More specifically, the user composes an e-mail and then uses the electronic stamp program 34 to append a stamp such as by using a drag-and-drop function. (Park at paragraph 51, steps S36 and S38 of FIG. 4 and FIG. 5). Thereafter, the e-mail composer transmits the e-mail, *with the appended stamp.* (Park at paragraph 52, step S40 of FIG. 4). Therefore, the e-mail is appended *prior to* any transmission of the e-mail.

In contrast, claim 14 specifically states that the advertisement retrieval software is appended to an e-mail *transmitted from the first client computer.* Thus, claim 14 requires an e-mail message to have already been transmitted from a first computer to a second computer *prior to appending the software.* Appending software *prior* to transmitting an e-mail is not the same as appending software to an e-mail *after* the e-mail has been transmitted.

Accordingly, because the advertisement retrieval software of Park is appended prior to transmission of the e-mail, Park does not disclose appending advertisement retrieval software after transmission of the e-mail. "A claim is anticipated only if each

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and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Therefore, because the Examiner has failed to identify any prior art that discloses appending advertisement retrieval software after transmission of the e-mail as set forth in the claim, the Board of Appeals is respectfully requested to reverse this rejection of claim 14.

Discussion re: Patentability of Claim 21

Claim 21 is an independent claim which includes the limitation of "appending a sub-message associated with an advertisement to the e-mail at a host server while the e-mail is enroute to the recipient." This element differs from the element of claim 14 in that a "sub-message associated with an advertisement" is appended to an e-mail after the e-mail has been transmitted from a first computer. Nonetheless, the Examiner has relied upon the same components in Park in the rejection of claim 21 that were discussed above with respect to claim 14. Accordingly, because the advertisement retrieval software of Park is appended prior to transmission of the e-mail as discussed above, and because Park fails to teach any other appending of the e-mail, Park does not disclose appending an e-mail with a sub-message associated with an advertisement after transmission of the e-mail.

Therefore, because the Examiner has failed to identify any teaching in Park of appending an e-mail with a sub-message associated with an advertisement after transmission of the e-mail as set forth in the claim, the Board of Appeals is respectfully requested to reverse this rejection of claim 21.

Discussion re: Patentability of Claims 22 and 24

Claims 22 and 24 depend from and incorporate all the limitations of claim 21. Accordingly, claims 22 and 24 are patentable over the prior art for at least the same reasons as those set forth above in connection with claim 21.

Claims 15 and 25 are Not Anticipated by Park

Discussion re: Patentability of Claim 15

1. Claim 15 depends from Claim 14

As an initial matter, claim 15 depends from and incorporates all the limitations of claim 14. Accordingly, in addition to the reasons discussed below, claim 15 is patentable over the prior art for at least the same reasons as those set forth above in connection with claim 14.

2. Additional Limitations of Claim 15

Claim 15 depends from claim 14 and includes the following limitations:

The method of claim 14, further comprising the step of:
storing profile information about the e-mail user in the database, and wherein the information about the at least one of a plurality of advertisements stored in the database comprises target characteristics associated with each of the plurality of advertisements, and wherein the step of appending advertisement retrieval software means to the e-mail message comprises the steps of:
reading the e-mail user's e-mail address from the e-mail message;
identifying the e-mail user according to the e-mail user's e-mail address;
retrieving profile information about the e-mail user from the database;
comparing the e-mail user's retrieved profile information against the target characteristics associated with the advertisements;
selecting at least one advertisement comprising target characteristics which correlate positively to the e-mail user's profile information; and
appending advertisement retrieval software means to the e-mail message, the advertisement retrieval software means comprising information about the at least one selected advertisement.

Claim 15 thus recites that the *advertisement retrieval software* is selected by the system based upon profile information *of the sender of the e-mail.*

3.   A Generic Stamp is Not a Targeted Stamp

The Examiner has alleged that Park disclosed "targeted advertising." (Office
Action at page 3). The Examiner has misconstrued the claim.

Specifically, the Examiner identified paragraph 43 of Park as disclosing the
claimed step of appending advertisement retrieval software based upon a user profile.
(Office Action at page 3). Paragraph 43 of Park describes the appending of a stamp to an
e-mail. The actual content of the advertisement, however, is not discussed or even
known by the system in the steps of paragraph 43. Rather, the content of the
advertisement is selected by the system as described in paragraph 47 after the e-mail has
been received by the recipient. (Park at paragraph 47). Thereafter, the advertisement is
sent in a separate transmission. (Park at paragraph 59 and step S64 of FIG. 7). Thus, the
"stamp" of Park is a generic stamp and the "advertisement" is not appended to the e-mail.
In contrast, the claim recites that the appended advertisement retrieval software includes
information about an advertisement specifically selected based upon the sender's
information. Appending a generic stamp is not the same as appending a targeted
advertisement retrieval software. Moreover, while the advertisement of Park is targeted,
it is not appended to the e-mail.

Accordingly, because the stamp of Park is generic and the advertisement of Park
is not appended to the e-mail, Park does not disclose appending advertisement retrieval
software based upon target characteristics. Therefore, because the Examiner has failed to
identify any prior art that discloses appending advertisement retrieval software based

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target characteristics as set forth in the claim, the Board of Appeals is respectfully requested to reverse this rejection of claim 15.

4.   Park Does Not Disclose Sender Based Advertisement Retrieval Software

The Examiner has alleged that Park discloses selection of advertisement retrieval software based upon a user profile. (Office Action at page 3). The Examiner has misconstrued the claim.

Specifically, the Examiner identified paragraph 43 of Park as disclosing the claimed step of appending advertisement retrieval software based upon a user profile. (Office Action at page 3). Paragraph 43 of Park describes the appending of a stamp to an e-mail. The actual content of the advertisement, however, is not described in paragraph 43. Rather, the content of the advertisement is selected by the system as described in paragraph 47 based upon "user information of the *receiver*." (Park at paragraph 47)(emphasis added). Selecting an advertisement based upon *receiver* information is not the same as selecting advertisement retrieval software based upon *sender* information as claimed.

Specifically, claim 15 recites that the "e-mail user's" information is used to determine the advertisement retrieval software. As set forth in claim 14, the e-mail user is the e-mail *sender* while the "e-mail recipient" is the e-mail *receiver*.

Accordingly, because the advertisement content of Park is based upon receiver information, Park does not disclose appending advertisement retrieval software based upon sender information. Therefore, because the Examiner has failed to identify any prior art that discloses appending advertisement retrieval software based upon sender

information as set forth in the claim, the Board of Appeals is respectfully requested to reverse this rejection of claim 15.

5.   Conclusion

For any or all of the above reasons, it is respectfully submitted that Park does not anticipate claim 15 and the Board of Appeals is respectfully requested to reverse this rejection of claim 15.

Discussion re: Patentability of Claim 25

Claim 25 depends from claim 21 and includes all of the limitations of claim 21. Claim 21 further recites that the sub-message is selected by the system based upon profile information of the e-mail account used to generate the e-mail message which is appended. Therefore, for the purposes of this appeal, claim 25 recites the same limitations discussed above with respect to claim 15. Accordingly, claim 25 is patentable over the prior art for at least the same reasons set forth above with respect to the patentability of claim 15 over the prior art.

Claim 17 is Not Anticipated by Park

1.   Claim 17 depends from Claim 14

As an initial matter, claim 17 depends from and incorporates all the limitations of claim 14. Accordingly, in addition to the reasons discussed below, claim 17 is patentable over the prior art for at least the same reasons as those set forth above in connection with claim 14.

2.   Additional Limitations of Claim 17

Claim 17 depends from claim 14 and includes the following limitations:

> 17. The method of claim 14, further comprising the steps of:
> transmitting a return communication from the second client computer to the host server when the e-mail message is displayed on the second client computer; and
> accounting for advertising revenue and advertising expense in response to the receipt of the return communication by the host server.

Claim 17 thus recites that the accounting for advertising revenue and advertising expense is performed based upon a message that the *e-mail* has been viewed.

3.   Park Charges Based Upon Display of Advertisement

The Examiner has alleged that Park disclosed the claimed method of accounting for advertising revenue and advertising expense. (Office Action at page 3). The Examiner has misconstrued the claim.

Specifically, the Examiner identified paragraphs 60 and 61 of Park as disclosing the claimed step of accounting for advertising revenue and advertising expense. (Office Action at page 3). Paragraph 60 of Park describes the accounting as occurring "in a step S68" which is shown as occurring *after* the receipt of the actual advertisement. (See, e.g., Park at FIG. 7). Thus, it is possible in the system of Park to encourage the e-mail recipient to view the advertisement "by having the electronic stamp providing system 10 present an amount to be paid if the online advertisement is received." (Park at paragraph 61). Therefore, Park discloses that the accounting occurs after transmitting an advertisement to a recipient. At paragraph 47, Park more clearly identifies that after an advertisement is displayed, a transmission from the receiver's system to the electronic stamp providing system 10 is sent. Thus, the accounting of Park occurs based upon viewing of the *advertisement* by the recipient of the e-mail.

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In contrast, claim 17 recites that the return message which initiates an accounting is sent "when the e-mail message is displayed." Accounting based upon display of an e-mail with appended advertisement retrieval software is not the same as accounting based upon display of an advertisement which was retrieved using appended advertisement retrieval software in an e-mail.

Accordingly, because Park discloses an accounting based upon display of an advertisement which was retrieved using appended advertisement retrieval software in an e-mail, Park does not disclose an accounting based upon display of an e-mail with appended advertisement retrieval software. Therefore, because the Examiner has failed to identify any prior art that discloses an accounting based upon display of an e-mail with appended advertisement retrieval software as set forth in the claim, the Board of Appeals is respectfully requested to reverse this rejection of claim 17.

4.   Conclusion

For some or all of the above reasons, Park does not anticipate claim 17. Accordingly, the Board of Appeals is respectfully requested to reverse this rejection of claim 17.

Claims 18 and 27 are Not Anticipated by Park

Discussion re: Patentability of Claim 18

1.   Claim 18

Claim 18 recites the following limitations:

> 18. A method for sending e-mail messages appended with advertising, comprising the steps of:
> storing an identifier for an entity selected by an e-mail user;

transmitting an e-mail message addressed to at least one email recipient from a first client computer to a host server through at least one computer network, wherein the e-mail message comprises an e-mail address of the e-mail user, an e-mail address of the at least one e-mail recipient, a subject, and a body;

appending advertisement retrieval software means to the e-mail message transmitted from the first client computer, wherein the advertisement retrieval software means comprises information about at least one of a plurality of advertisements retrievably stored in a database;

transmitting the e-mail message from the host server to a second client computer through the at least one computer network based upon the e-mail address the of at least one e-mail recipient;

displaying the e-mail message on the second client computer;

retrieving at least one of the plurality of advertisements retrievably stored in the database for display with the e-mail message on the second client computer; and

accounting for a contribution to the entity identified by the stored identifier.

Claim 18 thus requires advertisement retrieval software to be appended to an e-mail that has already been transmitted and that the *user* select the identity of the entity that receives a contribution.

2. The Discussion of Claim 14 Applies

Claim 18 is an independent claim which includes the limitation of "appending advertisement retrieval software means to the e-mail message transmitted from the first client computer." This is the same "appending" limitation that was discussed above with respect to claim 14. The Examiner has relied upon the same components in Park in the rejection of claim 18 that were discussed above with respect to claim 14. Accordingly, in addition to the reasons discussed below, claim 18 is patentable over the prior art for at least the same reasons as those set forth above in connection with the "appending" elements of claim 14.

3. Park Charges Based Upon Display of an Advertisement

The Examiner has alleged that Park disclosed the claimed method of accounting for advertising revenue and advertising expense. (Office Action at page 3). Assuming

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arguendo that a "contribution" is an "accounting," which the Applicants do not admit, The Examiner has misconstrued the claim.

Specifically, the Examiner identified paragraphs 60 and 61 of Park as disclosing the claimed step of accounting for advertising revenue and advertising expense. (Office Action at page 3). Paragraph 60 of Park describes the accounting as occurring "in a step S68" which is shown as occurring after the receipt of the actual advertisement. (See, e.g., Park at FIG. 7). The claim recites, however, that the *e-mail user* selects the entity which receives the contribution. As clearly stated in paragraph 59, Park discloses that the accounting performed in paragraphs 60 and 61 results from the selection of an advertising entity by the *"electronic stamp providing system 10."* An e-mail user is not the same as an electronic stamp providing system.

The Applicants note that at FIG. 6 of Park, a variety of stamps are available for a user to select for inclusion in an e-mail. As described at paragraph 54, however, the different stamps are merely different visual designs. (Park at paragraph 54). There is no indication that the different images are associated in any way with different entities, thereby allowing the e-mail user to select the entity whose advertisement will be shown.

Accordingly, because Park discloses an accounting to an entity selected by a *system*, Park does not disclose a contribution to an entity selected by an *e-mail user*. Therefore, because the Examiner has failed to identify any prior art that discloses a contribution to an entity selected by an e-mail user as set forth in the claim, the Board of Appeals is respectfully requested to reverse this rejection of claim 18.

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4. Conclusion

For some or all of the above reasons, Park does not anticipate claim 18.

Accordingly, the Board of Appeals is respectfully requested to reverse this rejection of

claim 18.

Discussion re: Patentability of Claim 27

Claim 27 depends from claim 21 and includes all of the limitations of claim 21.

Claim 27 further recites that a contribution is made to an entity selected by the e-mail

user in response to a message generated when an advertisement is displayed. Therefore,

for the purposes of this appeal, claim 27 recites the same limitations discussed above

with respect to claim 18. Accordingly, claim 27 is patentable over the prior art for at

least the same reasons that claim 18 is patentable over the prior art.

Claim 19 is Not Anticipated by Park

1. Claim 19 depends from Claim 18

As an initial matter, claim 19 depends from and incorporates all the limitations of

claim 18. Accordingly, in addition to the reasons discussed below, claim 19 is patentable

over the prior art for at least the same reasons as those set forth above in connection with

claim 18.

2. Additional Limitations of Claim 19

Claim 19 depends from claim 18 and recites the following limitations:

> 19. The method of claim 18, further comprising the step of:
> storing profile information about the e-mail user in the database, and wherein the information
> about the at least one advertisement stored in the database comprises target characteristics associated with

each advertisement, and wherein the information about the e-mail user stored in the database comprises profile information about the e-mail user, and wherein the step of appending advertisement retrieval software means to the e-mail message comprises the steps of:

        reading the e-mail user's e-mail address from the e-mail message;

        identifying the e-mail user according to the e-mail user's e-mail address;

        retrieving profile information about the e-mail user from the database;

        comparing the e-mail user's retrieved profile information against the target characteristics associated with the advertisements;

        selecting at least one advertisement comprising target characteristics which correlate positively to the e-mail user's profile information; and wherein the step of appending comprises

        appending information about the at least one selected advertisement to the e-mail message.

Claim 19 thus recites that advertisement information appended to the e-mail message is based upon profile information *of the sender of the e-mail.*

3.   The Discussion of Claim 15 Applies

While claim 19 does not recite the identical limitation that was discussed above with respect to claim 15, the Examiner has relied upon the same components in Park in the rejection of claim 19 that were discussed above with respect to claim 15. Claim 19, like claim 15, requires information to be sent to an e-mail recipient based upon the sender's profile. Accordingly, because the advertisement information of Park is selected based upon *receiver* information as discussed above, Park does not disclose appending advertisement information to an e-mail based upon *sender* information.

Therefore, because the Examiner has failed to identify appending advertisement information to an e-mail based upon sender information as set forth in the claim, the Board of Appeals is respectfully requested to reverse this rejection of claim 19.

4.   Conclusion

For some or all of the above reasons, Park does not anticipate claim 19.

Accordingly, the Board of Appeals is respectfully requested to reverse this rejection of

claim 19.

Claim 23 is Not Obvious Over Park

Claim 23 depends from and incorporates all the limitations of claim 21.

Accordingly, claim 21 is patentable over Park for at least the same reasons as those set

forth above in connection with claim 21.

(8) CONCLUSION

Claims 14, 15, 17-19, 21-22, 24-25 and 27 are not anticipated by Park and claim

23 is not obvious over Park. Accordingly, the Board of Appeals is respectfully requested

to reverse the rejections of claims 14, 15, 17-19, 21-25 and 27.

Respectfully submitted,

MAGINOT, MOORE & BECK

James D. Wood
Attorney for Appellant
Registration No. 43,285

August 21, 2006
Maginot, Moore & Beck
Chase Tower
111 Monument Circle, Suite 3250
Indianapolis, Indiana 46204-5115
Telephone (317) 638-2922

(9) CLAIMS APPENDIX

Claim 14.   A method for generating revenue using electronic mail, comprising the steps of:

transmitting an e-mail message addressed to at least one e-mail recipient from a first client computer to a host server through at least one computer network, wherein the e-mail message comprises an e-mail address of an e-mail user, an e-mail address of the at least one e-mail recipient, a subject, and a body;

appending advertisement retrieval software means to the e-mail message transmitted from the first client computer, wherein the advertisement retrieval software means comprises information about at least one of a plurality of advertisements retrievably stored in a database;

transmitting the e-mail message from the host server to a second client computer through the at least one computer network based upon the e-mail address of the at least one e-mail recipient; and

displaying the e-mail message on the second client computer, wherein when the e-mail message is first displayed on the second client computer the advertisement software retrieval means is operable at the second client computer to retrieve at least one of the advertisements retrievably stored in the database for display with the e-mail message on the second client computer.

Claim 15.   The method of claim 14, further comprising the step of:

storing profile information about the e-mail user in the database, and wherein the information about the at least one of a plurality of advertisements stored in the database comprises target characteristics associated with each of the plurality of advertisements, and wherein the step of appending advertisement retrieval software means to the e-mail message comprises the steps of:

reading the e-mail user's e-mail address from the e-mail message;

identifying the e-mail user according to the e-mail user's e-mail address;

retrieving profile information about the e-mail user from the database;

comparing the e-mail user's retrieved profile information against the target characteristics associated with the advertisements;

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selecting at least one advertisement comprising target characteristics which correlate positively to the e-mail user's profile information; and

appending advertisement retrieval software means to the e-mail message, the advertisement retrieval software means comprising information about the at least one selected advertisement.

Claim 17.   The method of claim 14, further comprising the steps of:

transmitting a return communication from the second client computer to the host server when the e-mail message is displayed on the second client computer; and

accounting for advertising revenue and advertising expense in response to the receipt of the return communication by the host server.

Claim 18.   A method for sending e-mail messages appended with advertising, comprising the steps of:

storing an identifier for an entity selected by an e-mail user;

transmitting an e-mail message addressed to at least one e-mail recipient from a first client computer to a host server through at least one computer network, wherein the e-mail message comprises an e-mail address of the e-mail user, an e-mail address of the at least one e-mail recipient, a subject, and a body;

appending advertisement retrieval software means to the e-mail message transmitted from the first client computer, wherein the advertisement retrieval software means comprises information about at least one of a plurality of advertisements retrievably stored in a database;

transmitting the e-mail message from the host server to a second client computer through the at least one computer network based upon the e-mail address the of at least one e-mail recipient;

displaying the e-mail message on the second client computer;

retrieving at least one of the plurality of advertisements retrievably stored in the database for display with the e-mail message on the second client computer; and

accounting for a contribution to the entity identified by the stored identifier.

Claim 19.   The method of claim 18, further comprising the step of:

storing profile information about the e-mail user in the database, and wherein the information about the at least one advertisement stored in the database comprises target characteristics associated with each advertisement, and wherein the information about the e-mail user stored in the database comprises profile information about the e-mail user, and wherein the step of appending advertisement retrieval software means to the e-mail message comprises the steps of:

reading the e-mail user's e-mail address from the e-mail message;

identifying the e-mail user according to the e-mail user's e-mail address;

retrieving profile information about the e-mail user from the database;

comparing the e-mail user's retrieved profile information against the target characteristics associated with the advertisements;

selecting at least one advertisement comprising target characteristics which correlate positively to the e-mail user's profile information; and wherein the step of appending comprises

appending information about the at least one selected advertisement to the e-mail message.

Claim 21.   A method for advertising using electronic e-mail comprising:

composing an e-mail on a first client computer

sending the e-mail to a recipient;

appending a sub-message associated with an advertisement to the e-mail at a host server while the e-mail is enroute to the recipient;

delivering the appended e-mail to a second client computer;

displaying with the second client computer the advertisement associated with the sub-message;

transmitting a return communication from the second client computer to the host server when the advertisement is displayed by the second client computer; and

accounting with the host server for advertising revenue in response to the receipt of the return communication.

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Claim 22.   The method of claim 21, wherein:

the step of appending comprises appending an advertisement retrieval software means to the e-mail; and

the step of displaying comprises

retrieving an advertisement from a host computer with the advertisement retrieval software means, and

displaying the retrieved advertisement.

Claim 23.   The method of claim 21, wherein the step of appending comprises:

obtaining the sub-message associated with an advertisement from a data base with a third computer; and

appending the sub-message associated with an advertisement to the e-mail enroute to the recipient with the third computer.

Claim 24.   The method of claim 21, further comprising:

determining profile information regarding the e-mail recipient;

comparing the profile information with target characteristics associated with the advertisement; and

selecting the sub-message to be appended to the e-mail enroute to the recipient based upon the comparison.

Claim 25.   The method of claim 21, further comprising:

determining profile information regarding an e-mail account used to compose the e-mail;

comparing the profile information with target characteristics associated with the advertisement; and

selecting a sub-message associated with an advertisement based upon the comparison, and wherein:

the step of appending a sub-message associated with an advertisement to the e-mail enroute to the recipient comprises appending the selected sub-message.

Claim 27.   The method of claim 21, further comprising:

accounting for a contribution to an entity designated by the e-mail user in

response to the receipt of the return communication.

(10) EVIDENCE APPENDIX

None.

(11) RELATED PROCEEDINGS APPENDIX

None.